

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte LARRY STEVENS

Appeal No. 2002-0980
Application No. 09/228,325

HEARD: February 19, 2003

MAILED

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**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 2 and 4-18, all the claims currently pending in the application.

The Invention

Appellant's invention pertains to a basketball backboard assembly. As explained on page 2 of appellant's specification, it is known in the art to use a two-sided tape having a foam core to secure an acrylic backboard to a backboard frame assembly. Appellant

asserts, however, that the use of two-sided tape is not altogether satisfactory because it is time and labor intensive. In an effort to resolve this problem, appellant utilizes a catalyzed elastomeric adhesive in place of the conventional two-sided tape. According to appellant (specification, page 3), the application of catalyzed elastomeric adhesive may be automated and performed by commercially available robotic equipment, thereby improving the efficiency and cost of assembly, while at the same time allowing the cure time to be customized to provide an optimum time set.

Claim 1 is exemplary of the appealed subject matter, and reads as follows (with emphasis added):

1. A basketball backboard assembly sized and configured for playing the game of basketball comprising:

a backboard frame structure having a bonding surface;

an acrylic backboard having a bonding surface; and

a *catalyzed elastomeric adhesive* sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surfaces to be used in the game of basketball.

The Prior Art

The following references have been cited by the examiner as evidence of obviousness:^{1,2}

Nunes ³	5,677,896	Oct. 14, 1997
Hying et al. (Hying)	5,839,982	Nov. 24, 1998

Information About Specialty Materials for High Technology Applications, Dow Corning® Q3-6093 Silicone Adhesive, copyright 1987 (hereinafter, Dow Corning)⁴

3M™ Microspheres Performance Enhancements
(http://www.3m.com/market/industrial/additives/perfen_1.html) and 3M™ Microspheres Application-Market Matrix (<http://www.3m.com/market/industrial/additives/appguide.html>)
(collectively, 3M)

¹The publication date of the Dow Corning and 3M references has not been established; however, appellant does not dispute that they are prior art with respect to the claimed invention.

²The list of references relied upon in the examiner's answer also included US Patent 4,951,179 to Machida. In that this reference is not included in the statement of either of the examiner's rejections, its listing is presumed to be in error.

³This reference apparently was inadvertently omitted from the list of references relied upon on page 2 of the answer.

⁴Although the list of references relied upon on page 2 of the answer identifies this reference as "GE data sheet," it is clear from the explanation of the rejections in the final rejection and answer that the reference intended is the noted Dow Corning publication. In any event, whether the reference intended is Dow Corning or one of the several General Electric publication of record in this application, our decision in this appeal would be the same. This is so because the Dow Corning and General Electric publications are cited for essentially the same purpose, namely, to establish that catalyzed elastomeric silicone adhesives were known in the art at the time of appellant's invention, a fact acknowledged by appellant on page 5 of the specification.

LJS/lp

The Rejections

Claim 1 stands rejected 35 U.S.C. § 103 as being unpatentable over Hying in view of Dow Corning.

Claims 2 and 4-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hying in view of Dow Corning and further in view of Nunes and 3M.

Reference is made to appellant's main and briefs (Paper Nos. 16 and 20) and to the examiner's final rejection and answer (Paper Nos. 9 and 17) for the respective positions of appellant and the examiner regarding the merits of these rejections. Appellant also relies upon the declaration of Jerry Ward and the declaration of S. Curtis Nye in support of the position that the appealed claims are patentable over the applied references.

The Examiner's Position

Looking first at the rejection of claim 1, Hying pertains, in pertinent part, to a basketball backboard assembly comprising a backboard frame structure, and an acrylic backboard supported thereon. In the background section of the specification, Hying describes at column 1, lines 10-35, a known prior basketball backboard construction wherein a double-sided adhesive layer 5 is used to secure an acrylic backboard 3 to a

welded steel frame 1.⁵ According to Hying, this type of backboard construction suffers from a number of disadvantages, including insufficient strength of the adhesive to retain the acrylic backboard against the frame (column 2, lines 27-29) and exposure of the edges of the acrylic backboard, which edges are susceptible to cracking when struck by a ball or other object (column 2, lines 32-36). Hying's solution is to replace the double-sided adhesive with an extruded plastic channel member 13 for connecting the backboard to the backboard frame. In addition to connecting the backboard to the backboard frame, the channel member envelopes the backboard edges to thereby protect them from damage.

In rejecting claim 1, it appears that the starting point of the examiner's rejection is Hying's prior art double-sided adhesive layer backboard construction. The examiner concedes that this prior art construction does not use a catalyzed elastomeric adhesive to secure the backboard to the backboard frame as set forth in claim 1. The examiner relies on Dow Corning for a teaching that catalyzed elastomeric adhesives were known *per se* at the time of appellant's invention. According to the examiner, it would have been obvious to one of ordinary skill in the art to have employed the elastomeric adhesive of the Dow Corning to attach the backboard of Hying to the frame, the motivation being "to prevent injury to the players if the attachment means failed and to take advantage of their

⁵This known basketball backboard construction would appear to correspond to the prior art basketball backboard described on page 2, lines 3-8, of appellant's specification that the present invention seeks to improve upon.

desirable properties over wide temperature ranges" (answer, page 3). In the "Response to Arguments" section of the answer, the examiner further states:

[T]he Hying patent notes that [it] is old to use adhesives to bond the backboard to the support structure. The adhesive claimed is common and well known. It would be an obvious choice for one of ordinary skill in the art to use a readily available adhesive in the attachment of the backboard to the support. [Answer, page 7.]

Discussion

The initial burden is on the examiner to present evidence from which it can be concluded that a *prima facie* case of obviousness has been established. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Once a *prima facie* case has been established, the burden of going forward shifts to appellant. In the present case, it is our view that the examiner has not met his initial burden. Our reasons follow.

Like appellant, we find no teaching, suggestion, or inference in the combined teachings of the applied references that would have led the ordinarily skilled artisan to utilize the adhesive of Dow Corning to secure the acrylic backboard of Hying to the

backboard frame, as proposed by the examiner. The examiner's position to the effect that it would have been an "obvious choice" for one of ordinary skill in the art to use any readily available and suitable adhesive, and in particular the adhesive of Dow Corning, as a replacement for Hying's double-sided adhesive is without foundation in the absence of evidence supporting such a contention. More particularly, the examiner has not pointed out where the applied references teach that using Dow Corning's adhesive in Hying's environment would "prevent injury to the player," and/or precisely what "properties over wide temperature ranges" Dow Corning's adhesive possesses that the one of ordinary skill in the art would have found to be "desirable" in Hying's environment. In a nutshell, the examiner appears to take the position that it would have been obvious to try any number of prior art adhesives until one possibly arrived at a successful result where the prior art gives no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful. However, this not the standard of 35 U.S.C. § 103. See *In re Goodwin*, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6, 8-9 (CCPA 1977); *In re Tomlinson*, 363 F.2d 928, 931, 150 USPQ 623, 626 (CCPA 1966).

We also note that at various places in the answer (e.g., paragraph spanning pages 3-4) the examiner indicates that the particular adhesive utilized by appellant would have been an obvious matter of design choice in the absence of a showing of criticality. We do not agree with this position. In specifically disclosing the type of adhesive used in the invention, appellant has made clear that this adhesive has been chosen for its excellent adhesive and flexibility, controllable cure time, and adaptability to automated assembly (specification, pages 2-4). Far from being matters of obvious design choice, these matters are at the very heart of appellant's disclosed and claimed invention. The examiner cannot simply brush such features aside.

Under these circumstances, we conclude that the examiner has not established a *prima facie* case of obviousness of claim 1.

Turning to the rejection of claims 2 and 4-18 as being unpatentable over Hying in view of Dow Corning and further in view of Nunes and 3M, we have considered the Nunes and 3M additionally applied in this rejection but find nothing therein that makes up for the deficiencies of Hying and Dow Corning discussed above. Accordingly, the examiner also has not established a *prima facie* case of obviousness of these claims.

Regarding the declarations of Jerry Ward and S. Curtis Nye proffered by appellant in support of the patentability of the appealed claims, in that the examiner has not

established a *prima facie* case of obviousness, it is unnecessary for us to consider appellant's evidence of nonobviousness.

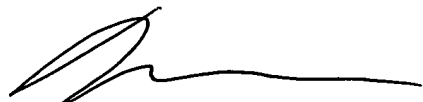
Conclusion

The rejection of claim 1 as being unpatentable over Hying in view of Dow Corning is reversed.

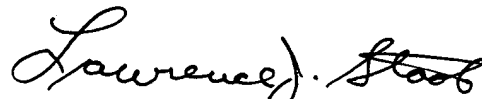
The rejection of claims 2 and 4-18 as being unpatentable over Hying in view of Dow Corning, Nunes and 3M is reversed.

The decision of the examiner finally rejecting the appealed claims is reversed.

REVERSED



NEAL E. ABRAMS
Administrative Patent Judge



LAWRENCE J. STAAB
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge

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